

REMARKS

Claims 12-17 were added as new claims in Applicant's response to the Office Action mailed on September 22, 2004. However, the Office Action Summary and the Examiner's Detailed Action failed to acknowledge the existence of claims 12-17 in either the Office Action mailed on January 25, 2005 or the present Office Action. Applicant submits that claims 12-17 recite statutory matter under 35 U.S.C. §101 are in condition for allowance and respectfully requests the same.

In the Office Action mailed from the United States Patent and Trademark Office on July 13, 2005, the Examiner rejected Claims 1-11 under 35 U.S.C. §101. Accordingly, Applicant respectfully provides the following.

The United States Patent and Trademark Office and the United States Court of Appeals for the Federal Circuit treat the utility requirement of 35 U.S.C. § 101 as a relatively low bar to patentability. For example, the MPEP advises examiners to impose a rejection based on lack of utility only if the claimed invention is not "useful for any particular purpose." See MPEP 2107 (emphasis added). The MPEP requires only "one single credible assertion of specific and substantial utility for each claimed invention to satisfy the utility requirement." Id. (emphasis added). In addition, the Federal Circuit said:

[The Court] never intended to create an overly broad, fourth category of [mathematical] subject matter excluded from Section 101. Rather, at the core of the Court's analysis . . . lies an attempt by the Court to explain a rather straightforward concept, namely, that certain types of mathematical subject matter, standing alone, represent nothing more than abstract ideas until reduced to some type of practical application, and thus that subject matter is not, in and of itself, entitled to patent protection.

In re Alappat, 33 F.3d 1526, 1543 (Fed. Cir. 1994)(emphasis added). Consequently, it is not surprising that the Federal Circuit has routinely upheld claims as sufficient under Section 101. For example, in In re Alappat and State Street Bank & Trust Co. v. Signature Fin. Group, Inc., 149 F.3d 1368 (Fed. Cir. 1998), the court upheld claims for machines that achieved certain results. In In re Alappat, a machine used mathematical algorithms to transform data into smooth waveforms. In State Street, a machine used mathematical calculations to transform data into a final share price. In addition, in Arrhythmia Research Technology Inc. v. Corazonix Corp., the court held that the transformation of electrocardiograph signals from a patient's heartbeat through a series of mathematical calculations was useful because it gave information about the condition of the patient's heart. 958 F.2d 1053 (Fed. Cir. 1992).

Similar to Arrhythmia, the present invention produces useful information assessing the success of professional development training. Contrary to the Examiner's rejection, the present invention is not mathematical subject matter "standing alone," rather it is a useful, tangible professional development tool for improving a teacher's effectiveness, and maximizing a student's ability to learn.


Consequently, Applicant respectfully requests withdrawal of the Examiner's rejections of claims 1-11 under 35 U.S.C. §101.

CONCLUSION

If any impediments to the allowance of this application for patent remain after the above remarks are entered, the Examiner is invited to initiate a telephone conference with the undersigned attorney of record.

DATED this 7 day of October, 2005.

Respectfully submitted,


Michael F. Krieger
Attorney for Applicant
Registration No. 35,232

KIRTON & McCONKIE
1800 Eagle Gate Tower
60 East South Temple
Salt Lake City, UT 84111
(801) 328-3600

SBO/rlh

854350.1